IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number:	09/852,200	Applicant:	Beckwith et al.
Filed:	2001.05.08	Examiner:	Michael D. Meucci
Group Art Unit:	2142	Customer Number:	**24,319**
Attorney Docket:	B1-4171	Title:	Multi-Client to Multi-Server Simulation Environment Control System (JULEP)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

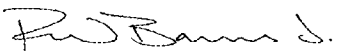
Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated in the following brief.

Any fees required by this document, including any extension of time, may be charged to deposit account 12-2252.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

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REMARKS

Claims 7-8, 10-17, 20, 22-23, 27, 30-33, 36, 38, and 41-46 are in the case. Claims 7-8, 10-17, 20, 22-23, 27, and 41 are rejected under 35 USC § 103. Claims 30-33, 36, 38, and 42-46 have been withdrawn from consideration. Thus, of the claims remaining under consideration, claim 41 is the only independent claim, and all remaining claims depend therefrom. Although several different combinations of references are used in the rejections, the primary combination used for the rejections is Kuo et al. in view of Redmond. This is the combination cited against independent claim 41.

A different third reference is added to this primary combination in the rejection of different sets of the independent claims. The examiner does not indicate that any of these "third references" is needed or useful in making a prima facia case against the independent claim 41. Thus, if claim 41 is patentable over the combination of Kuo et al. in view of Redmond, then all of the dependent claims are also patentable over the various combinations of references cited against them. Therefore, as this document has a limit of five pages (not counting the cover sheet), applicants will spend most of that allotment on a discussion of how claim 41 patentably defines over the primary combination of Kuo et al. in view of Redmond.

CLAIM REJECTIONS UNDER §103

Claim 41 is rejected over Kuo et al. in view of Redmond. Independent claim 41 claims, *inter alia*, a simulation environment running on a computer system and having at least one ***server process***, at least one ***client process***, and ***only one control process***, where all messages between the server process and the client process are ***controlled by and relayed through the control process***, the control process sets ***synchronization points*** in the server process, the synchronization points indicating points in time where the server process pauses ***until restarted by the control process***, where the server process, the client process, and the control process are ***all separate and distinct processes***.

Thus, independent claim 41 describes the following combination of elements: (1) only one control process, (2) at least one server process, (3) at least one client process, (4) where the control process, client process, and the server process are separate and distinct

processes, (5) all messaging between the server process and the client process is controlled by ***and*** relayed through the control process, and (6) the control process sets synchronization points where the server process pauses until restarted by the control process.

The combination of Kuo et al. and Redmond does not describe such a software system. Applicants first compare the primary reference against the elements of the claim as recited above, to determine wherein the primary reference is deficient. Then the secondary reference is analyzed to determine whether it compensates for the deficiencies detected in the primary reference. If both of the references are deficient as to the same element or combination of elements, then the claim is patentable over the cited references.

Kuo et al. are deficient in regard to elements (4), (5), and (6) as enumerated above. ***First***, the transaction message control mechanisms of Kuo et al. reside within the server process, whereas in the claimed system the control process and the server process are separate and distinct processes. As this deficiency is acknowledged by the examiner, applicants will not further substantiate the deficiency. ***Second***, the client processes of Kuo et al. control the messaging between the server process and the client processes, whereas in the claimed system all messaging between the server process and the client process are controlled by and relayed through the control process. As this deficiency is also acknowledged by the examiner, applicants will not further substantiate the deficiency.

Third, the ***control process*** of Kuo et al. does not set synch points in the server process in the manner as presently claimed in claim 41. Instead (according to the passage referenced by the examiner), the ***output process*** 48 (which is a part of the server process 42 as depicted in Fig. 2) controls the communication from the transaction process 50 (also a part of the server process 42) to the client process 40. The output process 48 synchronizes all of the transaction processes 50. Thus, Kuo et al. describe a server process that has internal synchronization, because ***all of the control and synchronization elements are disposed within the server process***. This is very different from the present invention as claimed, where the separate and distinct ***control process sets synchronization points*** in the separate and distinct server process, and the server process

stops until it is started again by the control process. The advisory action states that Kuo clearly describes synchronizing out put from the server, but this overly simplifies the claims. It is important that the proper element provides the synchronization in order for the claim to not be patentable, and Kuo et al. do not describe the synchronization as claimed.

Thus, there are at least three patentable distinctions between the system of Kuo et al. and the system as presently claimed. Redmond must compensate for all three of these deficiencies or the claim is patentable over the combination. However, Redmond does not compensate for any of the three deficiencies.

As to the ***first deficiency*** of Kuo et al. as recited above, Redmond does teach separate and distinct message data (clients?), central controller, and databases (servers?). Thus, for the moment only, applicants will accept that Redmond arguably teaches separate and distinct client processes, server processes, and control process. However, applicants assert that Kuo et al. and Redmond are improperly combined, as described in the next section in more detail. Therefore, the combination of Kuo et al. and Redmond does not fairly teach the separate and distinct client processes, server processes, and control process of the invention as claimed in claim 41.

In regard to the ***second deficiency*** of Kuo et al. as recited above, Redmond does not describe that all messages between the server process and the client process are controlled by ***and relayed through*** the control process – despite the simplistic drawing which might cause one to believe that the messages do pass through the central controller. Instead, Redmond describes that the central controller controls the external database ***to forward information*** matching the information request to the user (see block 114 of figure 4 and accompanying description). Thus, the central controller of Redmond ***does not relay*** all of the messages between the server process and the client process as presently claimed. Instead, the controller instructs the database to forward information directly to the user, without sending the information through the controller. In other words, the lines connecting the elements in the simplistic drawing of Redmond represent control lines, not data lines. Thus, the controller of Redmond is not performing the same function as the controller as claimed.

As to the ***third deficiency*** of Kuo et al. as recited above, Redmond is completely mute in regard to the control process setting synch points in the server processes. Thus, Redmond does not compensate for the third deficiency of Kuo et al. Therefore, the combination of Kuo et al. and Redmond is deficient in at least the second and third deficiencies as described above, and improperly combined in regard to the first deficiency, as described in more detail in the next section.

Thus, claim 41 patentably defines over Kuo et al. in view of Redmond. As described above, the additional "third references" are not used to compensate for these deficiencies of Kuo et al. in view of Redmond, but instead are used for the rejection of other elements that are claimed in the dependent claims. Therefore, none of the third references describe separate and distinct processes, where all messaging between the server process and the client process is controlled by and relayed through the control process, and the control process sets synchronization points in the server process.

IMPROPER COMBINATION OF REFERENCES

The claims recite certain elements in combination. Applicants do not at this time assert the claim that any one of these elements, taken by itself, is novel and has never before been seen. Thus, applicants anticipate that it might be possible to find each and every element somewhere in the prior art. Even so, applicants assert that they have combined these possibly-known elements in a novel and nonobvious manner to produce a product that has great benefits.

What the examiner has not done, and what the examiner must do, is provide proper motivation for making the selection and combination of prior art elements. Applicants assert that without the proper motivation, the combination of elements as recited by the examiner is not obvious. The mere fact that various elements ***could be*** placed in combination is not a sufficient motivation for actually making the combination. An infinite number of different elements ***could be*** placed in combination, but in order to make the present combination obvious, there must be an allowable motivation to make the combination.

Similarly, to just recite a benefit of the selected combination is also not sufficient. Almost every combination has one or more benefits of some type. Thus, the fact that a

given combination may have a certain benefit in common with many other different combinations does nothing to make that given combination obvious over any of the other combinations. Further, the identified benefits must be obvious from the prior art, and not just in light of the present invention.

Thus, it is respectfully submitted that the references cited do not support combining the elements as claimed in the present invention. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990) states that the PTO erred in rejecting a claimed invention as an obvious combination of the teaching of prior art references when the prior art provided no teaching, suggestion, or incentive supporting the combination. *See Northern Telecom Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2d 1321, 1323, *In re Geiger*, 2 U.S.P.Q.2D 1276, 1278. *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 U.S.P.Q.2d (BNA) 1468, 1475 (Fed. Cir.1988) states that one "cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention."

There is nothing in the prior art to lead a person of ordinary skill to design an apparatus like that of the present invention, other than the hindsight knowledge of this invention. However, the motivation to combine references cannot come from the invention itself. *See In re Oetiker*, 24 U.S.P.Q.2D 1443, 1446. The claims of the present application appear to have been used as a frame, and individual parts of separate prior art references were employed to recreate a facsimile of the claimed invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312.

The examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2D at 1438-1439. In the absence of such, applicants respectfully suggest that the references are improperly combined.

Sincerely,

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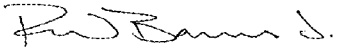
By: 

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